

Amendment and Response

Applicant: Jennifer Maw

Serial No.: 10/664,099

Filed: September 17, 2003

Docket No.: M190.151.101 / PD-267.00

Title: OTOLOGIC ADHESIVE APPLICATOR

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed September 22, 2006. In that Office Action, a restriction on the inventions of Group I (claims 1-17) and Group II (claims 18 and 29) under 35 U.S.C. §121. During a telephone interview with the Trevor Arnold on September 5, 2006, a provisional election to prosecute the invention of Group I without traverse was made. Further, claims 1-12 were rejected under 35 U.S.C. §102(b) as being anticipated by Dragan, U.S. Patent No. 4,569,662 ("Dragan"). Claims 13, 14, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dragan in view of Silverman et al., U.S. Patent No. 6,575,896 ("Silverman"). Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dragan in view of Wirt et al., U.S. Patent No. 6,648,852 ("Wirt").

With this Response, claims 15, 18, and 19 have been cancelled; claims 1, 16, and 17 have been amended; and claims 20 and 21 added. Claims 1-14, 16, 17, and 20-21 are pending in the application and are presented for consideration and allowance.

Restriction Requirement

The oral election to prosecute the invention of Group I (claims 1-17) is hereby confirmed. In accordance with this election, claims 18 and 19 have been cancelled.

35 U.S.C. §§102, 103 Rejections

Amended claim 1 relates to an adhesive applicator for applying medical adhesives to an ear, and includes a reservoir containing an otologic adhesive. In contrast, the dental syringe of Dragan is specifically configured to deliver different dental materials. *Dragan* at col. 1, ll. 47-50. Thus, Dragan does not teach a device including a reservoir containing otologic adhesive.

For at least the above reasons, it is respectfully submitted that the rejection of claim 1 has been traversed. In addition, it is respectfully submitted that amended claim 1 is not made obvious by Dragan (either alone or in combination with other references) because Dragan is non-analogous art. In order to rely upon a reference under 35 U.S.C. §103, it must be analogous prior art, meaning the reference must either be in the field of the applicant's endeavor, or, if not, then

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be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d, 1443, 1445 (Fed. Cir. 1992); *MPEP* §2141.01(a). With this standard in mind, the Applicant's field of endeavor is the delivery of medical adhesives to the ear of a patient. In contrast, Dragan relates to dental syringes. *Dragan* at col. 1, ll. 13-15. Thus, Dragan is from a different field of endeavor as compared to the pending application. Further, the pending application addresses the particular problem of delivering an otologic adhesive, particularly cyanoacrylate adhesives for otologic use, in a controlled fashion. Conversely, Dragan addresses the problem of providing a universal dental delivery tool for delivering various dental materials, with the dental materials being provided to the tool in different container formats. Thus, Dragan is not pertinent to the particular problem with which the inventor of the pending application was concerned. In light of this analysis, it is respectfully submitted that Dragan is not analogous art. As such, it is respectfully submitted that amended claim 1 is non-obvious over Dragan.

Claims 2-12 depend from amended claim 1, and thus for at least the reasons above, are not anticipated or made obvious by Dragan. In addition, it is respectfully noted that Dragan does not teach or suggest the "ring" limitation of claim 2, such that at least claim 2 recites additionally allowable subject matter.

With respect to the rejection of claim 13, 14, and 16 as being unpatentable over Dragan in view of Silverman, as well as claim 17 as being unpatentable over Dragan in view of Wirt, it is noted that claims 13, 14, 16, and 17 each depend from amended claim 1. As previously described, amended claim 1 is allowable over the cited art. For at least these reasons, then, it is respectfully submitted that claims 13, 14, 16, and 17 are also allowable. Notably, because Dragan is non-analogous art, Dragan is not available for rejecting claims 13, 14, 16, and 17 under 35 U.S.C. §103.

Newly Presented Claims

Newly presented claim 20 depends from claim 1 and thus, for at least the reasons above, is allowable. In addition, claim 20 recites that the trigger is pivotable relative to the handle from

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a maximum spacing position to a minimum spacing position. In addition, claim 20 recites that the dispensing mechanism and the reservoir are configured to dispense 5-10 μ L of the otologic adhesive from the reservoir with complete movement of the trigger from the maximum spacing position to the minimum spacing position. Support for this language is found, for example, at paragraph 11. This relatively small, but highly metered delivery volume is a direct result of the applicator's adaption for otologic applications. In contrast, the dental syringe of Dragan does not teach or suggest controlled delivery of volumes in the claimed range. In fact, because Dragan is limited to dental applications, Dragan has no need for ensuring metered, low-level dental material delivery volumes. Thus, it is respectfully submitted that claim 20 recites additionally allowable subject matter.

Newly presented claim 21 depends from claim 4 and thus, for at least the above reasons, is allowable. In addition, claim 21 recites that the trigger, including the process, is a homogenous, integrally formed body. Support for this language is found, for example, in paragraphs 11 and 12, as well as FIG. 2. In contrast, the trigger 29 and the separately formed ratcheting pawl 41 of Dragan are separately formed, and thus Dragan does not satisfy the limitations of claim 21. For at least these reasons, then, it is respectfully submitted that claim 21 recites additionally allowable subject matter.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-14, 16, 17, and 20-21 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-14, 16, 17, and 20-21 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

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Respectfully submitted,

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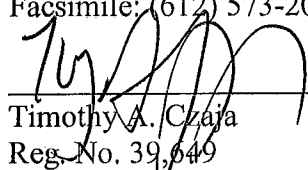
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